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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,865	12/02/2003	Jichen Wu	2011148	5576
Keith Kline PRO-TECHTOR INTERNATIONAL SERVICES 20775 Norada Court Saratoga, CA 95070-3018				
7590 11/27/2007			EXAMINER HO, TUAN V	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/726,865	Applicant(s) WU, JICHEN	
	Examiner Tuan V. Ho	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. It should be noted that the application has been transferred to a new examiner. After carefully reviewing the history of the application. Claims 1-7 are rejected again.
2. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/705,380 in view of Fujimoto et al.

Claims 1-7 are obvious variants of claims 1-3 of Application'380 with the reasons discussed in the last Office action, except for the circumferential walls of the hole and the opening are made of the same material.

Fujimoto et al teaches using holder 1 including opening 5; where the circumferential wall of hole 5 and opening are made of the same material (thermoplastic resin, [0027]) as shown in Fig. 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the walls of claims 1-7 as the same manner as disclosed by Fujimoto et al in order to obtain the circumferential walls of the hole and the opening are made of the same material because the modification would make manufacturing process of the holder easily and also simplify the process.

This is a provisional obviousness-type double patenting rejection.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jichen Wu et al (2005/0099659 A1) in view of Fujimoto et al (2004/0109079 A1).

As to claim 1, Wu et al. discloses an image sensor module (Fig. 2), comprising an image sensor package (Fig.2) formed with a top end face (52) having a transparent layer (74) and a bottom end face (54) (see [0018] and [0021]); a lens holder (46) formed with a chamber (68), which has an internal thread (64) formed at the inner wall, so that the transparent layer of the image sensor package is arranged at the lens holder (see [0020]); a lens barrel (46) inserted within the chamber of the lens holder, and formed with an external thread (66), which is screwed on the internal thread of the lens holder, the lens barrel being formed with an opening and a hole (62) communicating the opening; which is formed with a first positioned slot (see Fig.2) for positioning an aspheric lens (72), (see [0021]), except that the

circumferential walls of the hole and the opening are made of the same material.

Fujimoto et al teaches using holder 1 including opening 5; where the circumferential wall of hole 5 and opening are made of the same material (thermoplastic resin, [0027]) as shown in Fig. 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the walls of Jichen WU et al as the same manner as disclosed by Fujimoto et al in order to obtain the circumferential walls of the hole and the opening are made of the same material because the modification would make manufacturing process of the holder easily and also simplify the process.

As to claim 2, Wu et al. discloses the image sensor module according to claim 1, wherein the lens barrel is formed with a second positioned slot (see Fig. 2) under the first positioned slot for positioning an infrared filter (74) (see page 2, claim 2 of Wu).

As to claim 3, Wu et al. discloses the image sensor module according to claim 1, wherein the image sensor package includes a substrate (40), a frame arranged on the substrate (44), a photosensitive chip (42) arranged on the substrate and

electrically connected to the substrate by wires (60), and a transparent layer mounted on the frame layer (see Fig. 2, 74 mounted to 66).

As to claim 4, Wu et al. discloses the image sensor module according to claim 1, wherein the transparent layer is an infrared filter ("transparent layer is an infrared filter" see page 2, claim 2 of Wu).

As to claim 5, method claim 5 corresponds to apparatus claim 1 and is analyzed the same as discussed with respect to claim 1.

As to claim 6, Wu et al. discloses the method according to claim 6, wherein lens barrel is formed with a second positioned slot under the first positioned slot for positioning an infrared filter (see transparent layer 74 notched into 64 and 66 in Fig. 2).

As to claim 7, Wu et al. discloses the method according to claim 6, wherein the image sensor package includes a substrate, a frame arranged on the substrate (see 44 mounted on substrate 40 in Fig. 2), a photosensitive chip arranged on the substrate and electrically connected to the substrate by wires (see wires connected to left and right side of photosensitive chip 42 which

are connected to substrate), and a transparent layer mounted on the frame layer (see transparent layer 74 adjoined to (66 and 44)).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is (572) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600.


TUAN HO

Primary Examiner

Art Unit 2622